

REMARKS

This amendment is submitted in response to the non-final Office Action mailed November 1, 2005. In the Office Action, the Examiner:

- objected to pending claims 1 and 2 as lacking clarity concerning the scope of the claims, i.e., whether applicants intended to claim a “mechanism” or a combination of a “mechanism and the implants”;
- rejected pending claims 1-4, 6, 9, 10-12, 13-19, 20-22, 30-32 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,257,993 to Asher et al. (hereinafter “Asher”); and
- rejected pending claims 1-9, 13-18, 23-29 and 33-34 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 56,406,477 to Fujiwara (hereinafter “Fujiwara”).

Following entry of this amendment, claims 1-34 remain pending in the application. Applicants have amended claims 1-34 to further define the invention recited, more clearly distinguish over the cited prior art, conform with amendments to other claims and/or correct minor language inconsistencies. All amendments are fully supported by the originally-filed specification and/or drawings of the present application. No new matter has been added. The claim amendments made herein do not represent acquiescence in the Examiner’s rejections, but rather are made only to expedite prosecution of the present application and/or maintain consistency in claim language. Applicants expressly reserve the right to pursue the subject matter of any previously presented claims in one or more continuation applications. As discussed more fully below, Applicants respectfully submit that each of the currently pending claims define features that are not disclosed, taught or suggested by the prior art of record and respectfully requests allowance of same.

Claim Objections

The Examiner has objected to claims 1 and 2 as having an unclear scope. More particularly, the Office Action states that it is unclear whether applicants intended to claim the subcombination (mechanism) or combination (mechanism with implants). (Office Action at 2.) Since the Examiner has indicated that the claims were considered as being drawn to the combination (mechanism plus implants), applicants have amended the preamble

of each of claims 1-34 to recite a “system,” i.e., mechanism and implants, and have amended independent claims 1, 23 and 34 to also recite, *inter alia*, first and second implants.

Applicants respectfully submit that these amendments obviate the claim objections, and respectfully request withdrawal of same.

Claim Rejections 35 U.S.C. § 102(b) and § 102(e)

Each of pending claim 1-34 was rejected as anticipated by one or both of Asher and Fujiwara. Applicants respectfully traverse each of these claim rejections and, for the reasons discussed below, submit that neither cited reference discloses, teaches or suggests each of the limitations recited in amended independent claims 1 and 23.

As amended, independent claim 1 recites a bone fixation system for coupling a first fracture fixation implant to a second fracture fixation implant, comprising, *inter alia*, a body member including at least one prong extending from the body member for contacting a surface of the second implant to substantially prevent rotation of the second implant with respect to the first implant wherein the second implant defines a longitudinal axis, and “the at least one prong permits sliding of the second implant with respect to the first implant along the longitudinal axis.” Support for this amendment is found throughout the originally-filed specification of the present application, as shown below:

[F]irst and second stops 92, 94 may be selectively spaced apart along longitudinal axis 30 to provide for a desirable amount of sliding between implant 20 and intramedullary nail 22, such as to provide for compression between the two fractured bone fragments.

(Specification at Para. [0055]; *see also* Para. [0047].) Claim 23 has been similarly amended.

Applicants respectfully submit that neither of Asher or Fujiwara disclose the claimed at least one prong permitting sliding of the second implant with respect to the first implant along the longitudinal axis of the second implant. Asher discloses an apparatus for use in retaining a longitudinal member, i.e., a rod, in position relative to a spinal column. (Asher at Abstract.) Asher does not disclose a prong that, when engaged, permits relative sliding of implants, as recited in independent claim 1. Fujiwara discloses an intramedullary nail and lag screw assembly including a spacer that, when engaged, prevents *both* sliding and rotation of the lag screw with respect to the nail.

[T]he set screw 42 pushes down the whole of the spacer 46 and the lower ends of the legs 46b come into engagement with the grooves 34 of the lag screw 22, thereby securing the lag screw 22 in the nail member 16 while at the same

time preventing the rotation of the lag screw 22. Even in the case where the grooves 34 are not formed on the periphery surface of the lag screw 22, the lag screw 22 can be secured in the nail member 16 by being clamped between the nail member 16 (particularly the surface of the main through hole 24) and the spacer 46 due to the friction between the lower ends of the legs 46b of the spacer 46 and the peripheral surface of the lag screw 22.

(Fujiwara at col. 5, lines 20-33.) Therefore, Fujiwara also fails to disclose the claimed at least one prong permitting sliding of the second implant with respect to the first implant along the longitudinal axis of the second implant.

Accordingly, since both Asher and Fujiwara fail to disclose, teach or suggest all of the elements recited in amended claims 1 and 23, applicants respectfully request that the anticipation rejection of claims 1 and 23 be withdrawn and that these claims, and each of their dependent claims 2-22 and 24-33, be allowed.

New Independent Claim 34


Dependent claim 34 has been rewritten as an independent claim and, in addition to all of the limitations of amended claim 1, also recites that the at least one prong has "a length, a width and a thickness, such that the length and width of the at least one prong are both greater than its thickness." Applicants respectfully submit that this amendment is fully supported by the originally-filed specification and drawings, *see, e.g.*, FIGS. 8-10. Applicants respectfully submit that amended claim 34 distinguishes over the cited art for at least the same reasons as amended claim 1, and respectfully request allowance of same.

In view of the above amendments and remarks, Applicants respectfully request that the Examiner reconsider pending claims 1-34 with a view towards allowance. The Examiner is invited to call the undersigned attorney at (212) 326-3939 if a telephone call could help resolve any remaining issues.

A separate petition for a one-month extension of time is submitted herewith. Should any additional fees be required, please charge such fees to Jones Day deposit account no. 50-3013.

Respectfully submitted,

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